

REMARKS

Applicants respectfully request consideration of the subject application as amended herein. This Amendment is submitted in response to the Office Action mailed November 14, 2008. Claims 1-6 and 8-32 stand rejected. In this Amendment, claims 1, 20 and 31-32 have been amended. No claims have been canceled. No new matter has been added.

35 U.S.C. §112

The Examiner has rejected claims 1, 20 and 31-32 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. In particular, the Examiner states that “[t]he specification does not provide detailed support for such amendment to describe that the indicated pre-selected data has been detected based on the abstract data structure without using the pre-selected data.” (Office Action, dated November 14, 2008, p. 3, item 8). Applicants have amended claims 1, 20 and 31-32 to “the indication being detected based on the abstract data structure without searching for the data elements of the pre-selected data.” Applicants respectfully point to the language of the Specification at paragraphs 92 to 99 describing examples of the indication being based on the abstract data structure without searching for the data elements of the pre-selected data. Therefore, applicants respectfully request that the Examiner withdraw the rejection under 35 U.S.C. §112, first paragraph.

The Examiner has rejected claims 1, 20 and 31-32 under 35 U.S.C. §112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner states that it “is unclear as to how there is an indication being detected based on the abstract data structure without using the pre-selected data, when the abstract data structure is derived from the pre-selected data.” (Office Action, dated November 14, 2008, p. 4, item 10).

Applicants respectfully point to the language of the Specification at paragraphs 92 to 99 describing examples of the indication being based on the abstract data structure without searching for the data elements of the pre-selected data. Therefore, applicants respectfully request that the Examiner withdraw the rejection under 35 U.S.C. § 112, second paragraph.

35 U.S.C. §103

The Examiner has rejected claims 1-3, 6, 8-15, 20-21, 24-26 and 31-32 under 35 U.S.C. §103(a) as being unpatentable over Bradshaw (U.S. Patent No. 5,835,722, hereinafter “Bradshaw”), in view of Shannon (U.S. Patent No. 6,233,618, hereinafter “Shannon”).

Claim 1 recites in part:

receiving an abstract data structure derived from data elements of pre-selected data to be protected, the pre-selected data being stored on a server;
searching, locally, text contained in a plurality of documents stored on a plurality of data storage media of the client device for an indication that at least a portion of the pre-selected data stored on the server may be contained in the text of the plurality of documents, the indication being detected based on the abstract data structure without searching for the data elements of the pre-selected data;
detecting locally at least a portion of the pre-selected data in the text of at least one of the plurality of documents stored on any of the plurality of data storage media of the client device, **the detection indicating that a user of the client device has caused the portion of the preselected data residing on the server to be stored on the client device...**

(Emphasis added).

The present invention is directed to detecting prior acts of the user with respect to the protected data. In particular, claim 1 describes “the detection indicating that a user of the client device has caused the portion of the preselected data residing on the server to be stored on the client device.” (Emphasis added). In contrast, Bradshaw is directed to preventing future access to vulgar Internet sites and future creation of vulgar documents. Specifically, Bradshaw describes blocking attempts to use, access and transmit of vulgar and pornographic material. (Bradshaw, Abstract). In particular, Bradshaw blocks access to certain Internet sites, future production of

documents, sending e-mail with vulgar and offensive words, etc. (Bradshaw, col. 2, lines 61-67). When a user types “mukky” in an word processor, Bradshaw blocks the system. (Bradshaw, col. 11, lines 29-31). When a user tries to find a pornographic site like “http://www.mukky.com” by typing “naked,” “bare,” and “sex” in a search engine, Bradshaw blocks the system. (Bradshaw, col. 11, lines 43-48). Bradshaw does not disclose that the detection indicates that a user of the client device has caused the portion of the preselected data residing on the server to be stored on the client device because, in Bradshaw, users are blocked from accessing the vulgar or pornographic material on a server and cannot cause this material to be stored on their computer. Therefore, Bradshaw does not teach or suggest “detecting locally at least a portion of the pre-selected data in the text of at least one of the plurality of documents stored on any of the plurality of data storage media of the client device, **the detection indicating that a user of the client device has caused the portion of the preselected data residing on the server to be stored on the client device,**” as set forth in claim 1. (Emphasis added).

Shannon does not teach or suggest the features lacking in Bradshaw. Shannon describes clients that send requests for web pages provided by servers. (Shannon, Abstract). A network device, such as a proxy server, receives the client request and analyzes data in the client’s request to determine if the request should be forwarded for processing by a server. (Shannon, Abstract). If a client requesting access to a web page is excluded from the authorized clients, the network device will deny the client access to the web page. (Shannon, col. 8, lines 6-12). Therefore, Shannon describes a network device analyzing a client request to prevent future access to web pages by the client. Shannon is not directed towards detecting prior acts of the user with respect to the protected data. Shannon does not describe that the detection indicates that a user of the client device has caused the portion of the preselected data residing on the server to be stored on the client device because Shannon searches a client request before a client is even given access to

data on a server. In contrast, claim 1 describes “detecting locally at least a portion of the pre-selected data in the text of at least one of the plurality of documents stored on any of the plurality of data storage media of the client device, **the detection indicating that a user of the client device has caused the portion of the preselected data residing on the server to be stored on the client device.**” (Emphasis added).

Hence, Shannon is missing the same limitations as Bradshaw. Accordingly, the cited references, taken alone or in combination, do not teach or suggest the limitations of the present invention that are included in the language of claim 1.

Similar language is also included in independent claims 20 and 32. Accordingly, the present invention as claimed in independent claims 1, 20 and 32 and their corresponding dependent claims are patentable over the cited references.

Claim 31, as amended, recites in part:

at least one processor coupled to the plurality of storage media, at least one processor executing a set of instructions which cause the processor to search locally the text in the plurality of documents stored on a plurality of data storage media of the client device for an indication that at least a portion of the pre-selected data stored on the server may be contained in the text of the plurality of documents, the indication being detected based on the abstract data structure without searching for the data elements of the pre-selected data, **to detect locally at least a portion of the pre-selected data in the text of at least one of the plurality of documents stored on any of the plurality of data storage media of the client device, the detection indicating that a user of the client device has caused the portion of the preselected data residing on the server to be stored on the client device,** and to send, from the client device to the server, a notification of the detection of the portion of the pre-selected data in the text of at least one of the plurality of documents stored on any of the plurality of data storage media of the client device, the client device being a personal computing device.

(Emphasis added).

As noted above, neither Bradshaw nor Shannon teach or suggest detecting locally at least a portion of the pre-selected data in the text of at least one of the plurality of documents stored on any of the plurality of data storage media of the client device, the detection indicating that a

user of the client device has caused the portion of the preselected data residing on the server to be stored on the client device. Therefore, the cited references, taken alone or in combination, do not teach or suggest the limitations of the present invention that are taught in claim 31.

Accordingly, the present invention as claimed in independent claim 31 and its corresponding dependent claims is patentable over the cited references.

Claims 4, 16-19, 22 and 27-30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bradshaw, in view of Shannon, and further in view of Brandt (U.S. Patent No. 5,892,905, hereinafter “Brandt”) filed December 23, 1996. Claims 4 and 16-19 are dependent on claim 1. Therefore, claims 4 and 16-19 include the same limitations as claims 1. Claims 22 and 27-30 are dependent on claim 20. Therefore, claims 22 and 27-30 include the same limitations as claims 20. As noted above, Bradshaw and Shannon, taken alone or in combination do not teach or suggest the limitations recited in claims 1 and 20. These features are also missing from Brandt. Brandt provides a common user interface for a software application accessed via the Internet. A software application runs on a web server computer system. However, Brandt does not teach or suggest the limitations recited in claim 1. Thus, claims 4, 16-19, 22 and 27-30 are patentable for at least the same reasons as given above with respect to claims 1 and 20.

Claims 5 and 23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bradshaw, in view of Shannon, further in view of Brandt (US Patent No. 5,892,905, hereinafter “Brandt”) filed December 23, 1996, and further in view of Dascalu (US Patent No. 5,958,015) filed October 29, 1996. Claim 5 is dependent on claim 4, which is dependent on claim 1. Therefore, claim 5 includes the same limitations as claim 1. Claim 23 is dependent on claim 20. Therefore, claim 23 includes the same limitations as claim 20. As noted above, Bradshaw and Shannon, taken alone or in combination do not teach or suggest the limitations recited in claims 1 and 20. These features are also missing from Dascalu. Dascalu teaches a session wall that

listens to communications sent over the network. It listens to communication messages exchanged between a client and a server and determines whether the messages can be permitted based on stored access rules. However, Dascalu does not teach or suggest the limitations recited in claims 1 and 20. Thus, claims 5 and 23 are patentable for at least the same reasons as given above with respect to claims 1 and 20.

Applicants respectfully request the withdrawal of the rejections under 35 U.S.C. §103(a) and submit that all pending claims are in condition for allowance, which action is earnestly solicited.

Deposit Account Authorization

Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due. Furthermore, if an extension is required, then Applicant hereby requests such extension.

If the Examiner determines the prompt allowance of these claims could be facilitated by a telephone conference, the Examiner is invited to contact Joan O. Arbolante at (408) 720-8300.

Respectfully submitted,
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: February 17, 2009

/Joan Obispo Arbolante/
Joan Obispo Arbolante
Reg. No. 58,642

1279 Oakmead Parkway
Sunnyvale, CA 94085-4040
(408) 720-8300